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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,283	12/16/2003	William H. Retsch JR.	1902A1	6569

7590 02/03/2006

PPG INDUSTRIES, INC.
Intellectual Property Department
One PPG Place
Pittsburgh, PA 15272

EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/737,283

Applicant(s)

RETSCH ET AL.

Examiner

Ana L. Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 25, 2005
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 6, 7, 10, 16-25, 27-30, 33, 34, 37, 43-58 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 8, 9, 11-15, 26, 31, 32, 35, 36, 38-42 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 2, 3, 6, 7, 10, 16-25, 27-30, 33, 34, 37, 43-58 and 60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 9, 2005.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 8, 9, 11-15, 26, 35, 36, 38-42 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,617,418 (Magnusson et al) as per reasons of record.

4. Claims 26, 35, 36, 38-42 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0043152 A1 (Barsotti et al) as per reasons of record.

5. Claims 1, 4, 5, 8, 9, 11-15, 26, 31, 32, 35, 36, 38-42 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,376,637 (Bruchmann et al) in combination with U.S. 5,788,989 (Jansen et al) as per reasons of record.

Response to Arguments

6. Applicant's arguments filed November 25, 2005 have been fully considered but they are not persuasive.

Regarding Magnusson et al, applicants' main argument is that patentees' hyperbranched polyether is prepared by a ring opening of oxetane and not by a step-growth polymerization. Magnusson et al, however, clearly teach that the ring-opened oxetane can be mixed (condensation polymerized) with additional reactive comonomers, such as, polyalcohols, polyepoxides, polyanhydrides, etc. (claim 9, column 2, lines 39-43, etc.) so as to obtain hyperbranched polyethers having one or more other monomeric or polymeric units. Accordingly, it is maintained that it would have been obvious to one having ordinary skill in the art to have employed a hyperbranched polyether that is obtained from a (condensation polymerizable) reaction mixture comprising the ring-opened oxetane with additional reactive comonomer(s) in place of the hyperbranched polyether that is reacted with caprolactone per example 2.

As to Barsotti et al, applicants' argument that patentees react all the monomers at the same time is not well taken. Barsotti et al clearly teach alternative two-step processes for preparing their highly branched copolyesters inclusive of one wherein the highly branched polyfunctional monomers are first polymerized (said product corresponding to the present highly branched polymer having terminal functional groups) followed by polymerization of the chain extender lactone (corresponding to the presently claimed lactone). In essence, the disclosure of the reference differs in essence from the above-rejected claims in not expressly disclosing the coating composition in powder form. It is reasonably maintained, however, that it would have been obvious and within the purview of one having ordinary skill in the art to have formulated the coating compositions in powder form in accordance with the ultimate application and use

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desired. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

With respect to the rejection based on Bruchmann et al in combination with Jansen et al, it is maintained that it would have been obvious to one having ordinary skill in the art to have modified the polyurethane dendrimers of Bruchmann et al with a lactone component, as opposed to an alkylene oxide, because lactones and alkylene oxides are suitable alternative reactants for further modifying the terminal groups of dendrimers (Jansen et al column 5, line 59, column 6, line 4). Alternatively, it would have been obvious to one having ordinary skill in the art to have employed a polyurethane dendrimer, as taught by Bruchmann et al, in the composition of Jansen et al and further react it with a lactone. This is because Bruchmann et al clearly state, "all dendrimers can be used in the invention" (column 4, line 31).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

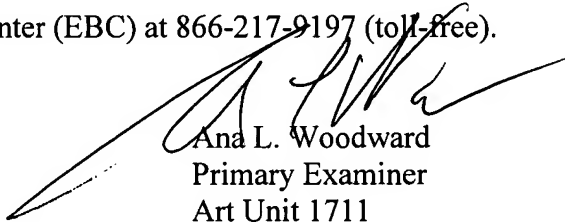
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward
Primary Examiner
Art Unit 1711
